

REMARKS

Applicant is in receipt of the Office Action mailed August 8, 2005. Claims 1, 16, and 31 have been amended. Claims 9, 24, and 39 have been cancelled. Claims 1-8, 10-23, 25-38, and 41-45 are pending in the case. Reconsideration of the present case is earnestly requested in light of the following remarks.

Section 102 Rejections

Claims 1-7, 15-22, 30-37, and 45 were rejected under 35 U.S.C. 102(e) to Schuster et al. (U.S. Patent No. 6,822,957 B1, "Schuster"). Applicant respectfully traverses the rejection.

Applicant has amended claim 1 to include the subject matter of original claim 9, now cancelled. The Examiner's arguments directed to claim 9 are thus addressed with reference to amended claim 1.

As the Examiner is certainly aware, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Amended claim 1 recites:

1. A method for configuring an IP telephone, comprising:
receiving an identifier from the IP telephone;
determining if a MAC ID for the IP telephone is valid;
if the MAC ID is determined to be valid, determining if the identifier is valid; and
if the identifier is valid, assigning a range of port numbers to the IP telephone
based on the identifier, wherein the IP telephone is operable to use at least a subset of the
range of port numbers to send or receive IP communications.

Applicant respectfully submits that Schuster nowhere teaches or suggests “determining if a MAC ID for the IP telephone is valid; if the MAC ID is determined to be valid, determining if the identifier is valid”. Rather, Schuster discusses the possibility of using MAC protocol addresses as internal network addresses (col. 15:9-20):

In an illustrative embodiment of the present invention, the internal network addresses for first computer network 12 are IP 48 addresses. For example, PC 14 has an internal IP address of 10.0.0.5 (FIG. 1), printer 16, 10.0.0.2, PC 18, 10.0.0.3, hand-held computer 20, 10.0.0.4, network phone 22, 10.0.0.5, proxy server 24, 10.0.0.6, and router 26, 10.0.0.7 in FIG. 1. The internal addresses are preferably not published on the external computer network (e.g., the Internet or an intranet). Other internal network addresses could also be used (e.g., Medium Access Control ("MAC") protocol addresses).

Nowhere in the cited text (or elsewhere) does Schuster teach or suggest determining if a MAC ID for the IP telephone is valid, and validating an identifier for the IP telephone contingent upon the MAC ID being valid, nor performing such validation prior to a port range assignment for the IP telephone.

The Office Action admits that Schuster fails to disclose “determining if a MAC ID for the IP telephone is valid; if the MAC ID is determined to be valid, determining if the identifier is valid”, but asserts that Fijolek remedies this admitted deficiency of Schuster, citing col. 8: 22-36. Applicant respectfully disagrees.

The cited text reads:

Above the RF interface 40 in a data-link layer 42 is a Medium Access Control ("MAC") layer 44. As is known in the art, the MAC layer 44 controls access to a transmission medium via physical layer 38. For more information on the MAC layer protocol 44 see IEEE 802.14 for cable modems. However, other MAC layer protocols 44 could also be used and the present invention is not limited to IEEE 802.14 MAC layer protocols (e.g., MCNS MAC layer protocols and others could also be used).

Above the MAC layer 44 is an optional link security protocol stack 46. The link security protocol stack 46 prevents unauthorized users from making a data connection from cable network 14. The RF interface 40 and the MAC layer 44 can also be used for an upstream cable connection in a data-over-cable system 10 without telephony return.

Per the cited text, Fijolek discloses using MAC layer protocols to control access to a transmission medium used in a cable network. Nowhere does Fijolek teach or suggest “determining if a MAC ID for the IP telephone is valid; if the MAC ID is determined to be valid, determining if the identifier is valid”.

The Examiner further asserts that Schuster and Fijolek in combination teach “determining if a MAC ID for the data link layer is valid; and if the MAC ID is determined to be valid, then determining if the identifier is valid such as that taught by Fijolek et al. in order to provide a variety of service offerings via and through a data-over-cable system”, citing col. 5:4-5. The cited text reads:

Thus, preferred embodiments of the present invention may provide a variety of service offerings via and through a data-over-cable system.

Applicant submits that Schuster and Fijolek not only fail to teach or suggest these limitations, but that the limitations cited by the Office Action are not the same as those of amended claim 1 (original claim 9). For example, the Office Action refers to a MAC ID for a *data link layer*, not an IP telephone. Further, the Office Action refers to providing a variety of service offerings via and through a *data-over-cable system* (Fijolek). Applicant respectfully submits that these features and limitations are not equivalent to those of amended claim 1, and further are not germane to the patentability of amended claim 1.

Thus, for at least these reasons, Applicant submits that claim 1 and those claims dependent therefrom are patentably distinct and non-obvious over Schuster. Moreover, Applicant further submits that Schuster and Fijolek, taken singly or in combination, fail to teach or suggest all the features and limitations of amended claim 1, and so claim 1 and those claims dependent therefrom are patentably distinct and non-obvious over Schuster and Fijolek, and are thus allowable.

Claims 16 and 31 include similar limitations as claim 1, and so the above arguments apply with equal force to these claims. Thus, for at least the reasons provided above, Applicant submits that claims 16 and 31, and those claims respectively dependent therefrom, are patentably distinct and non-obvious over Schuster (and Schuster and Fijolek), and are thus allowable. Removal of the section 102 rejection of claims 1-7, 15-

22, 30-37, and 45 is earnestly requested.

Section 103 Rejections

Claims 8-14, 23-30, 38, and 40-44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster in view of Fijolek et al. (U.S. Patent No. 6,577,642, “Fijolek”). Applicant respectfully traverses the rejection.

First, Applicant submits that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since the independent claims have been shown to be patentably distinct and non-obvious, their respective dependent claims are similarly patentably distinct and non-obvious, and are thus allowable.

Additionally, Applicant submits that various of the dependent claims include limitations not taught or suggested by Schuster and/or Fijolek. For example, the Office Action admits that Schuster fails to teach all the features and limitations of claim 8, specifically, “wherein the identifier comprises a vendor class identifier”, but then asserts that Fijolek remedies this admitted deficiency of Schuster, citing col. 10:60-67, col. 11:5-9, col. 11-col. 12, and Table 1. Applicant respectfully disagrees.

Applicant submits that Fijolek does not disclose a *vendor class identifier*, but rather discloses a vendor ID included in a configuration file that is sent to a cable modem or a CPE (Customer Premise Equipment), e.g., a personal computer, which is not the same thing, nor used for the same purpose. Applicant notes, for example, that the vendor class identifier recited in claim 8 is a standard DHCP option (specifically, option #60). Fijolek nowhere describes the vendor ID as a *vendor class ID*. Additionally, Fijolek’s vendor ID is included in a configuration file that is sent to the cable modem (or CPE) *after* the IP address has been assigned to the device. In direct contrast, in the present invention as represented in claim 8, the vendor class identifier is provided *prior to* port range or IP address assignment.

Thus, Applicant respectfully submits that Fijolek and Schuster fail to teach or suggest this limitation of claim 8. Claims 23 and 38 include similar limitations as claim 8, and so the above arguments apply with equal force to these claims. Thus, for at least these reasons, claims 8, 23, and 38, and those claims respectively dependent therefrom, are patentably distinct and non-obvious over Fijolek and Schuster, and are thus allowable.

Arguments are provided above against the 103(a) rejection of original claim 9, now cancelled, and whose subject matter has been incorporated into the independent claims.

Applicant notes that to establish a prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In *re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. In *re Bond*, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

Moreover, as held by the U.S. Court of Appeals for the Federal Circuit in *Ecolchem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis.

In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” In *re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Regarding the Examiner’s attempted combination of Schuster and Fijolek, Applicant respectfully submits that a proper motivation to combine has not been provided. For example, the only motivation to combine suggested by the Examiner is “in order to provide a variety of service offerings via and through a data-over-cable system”.

Applicant submits that such a general statement (actually, a quotation from Fijolek) in no way constitutes a proper motivation to combine the references. Note that per *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), the art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Nowhere does Schuster indicate the desirability of determining if a MAC ID for the IP telephone is valid, and if the MAC ID is determined to be valid, determining if the identifier is valid. Nor does Fijolek indicate the desirability of using a MAC ID of a telephone for this purpose, nor do Schuster or Fijolek indicate the desirability of using a vendor class identifier as an identifier for an IP telephone. Thus, Applicant submits that the attempted combination of Schuster and Fijolek is improper. Moreover, Applicant submits that even were Schuster and Fijolek properly combinable, which Applicant argues they are not, the resulting combination would still not produce Applicant's invention as claimed, as argued at length above.

Thus, Applicant submits that Schuster and Fijolek, taken singly or in combination, fail to teach all the features and limitations of claims 8-14, 23-30, 38, and 40-44 (and amended independent claims 1, 16, and 31) as argued above). Thus, for at least these reasons, Applicant respectfully submits that claims 8-14, 23-30, 38, and 40-44, and those claims respectively dependent therefrom, are patentably distinct and non-obvious over Schuster and Fijolek, and are thus allowable.

Removal of the section 103 rejection of claims 8-14, 23-30, 38, and 40-44 is earnestly requested.

Applicant has also provided arguments above showing that amended independent claims 1, 16, and 31 are also patentably distinct and non-obvious over Schuster and Fijolek, taken singly or in combination.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

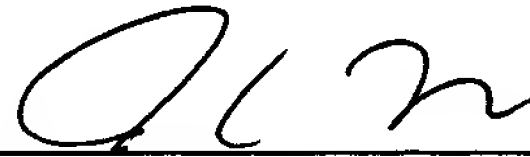
Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5686-00300/JCH.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Notice of Change of Address

Respectfully submitted,



Jeffrey C. Hood
Reg. No. 35,198
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert & Goetzel PC
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8800
Date: 11/8/2005 JCH/MSW